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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,564	11/28/2001	Carol T. Schembri	10981612-2	5249

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EXAMINER

TRAN, MY CHAU T

ART UNIT PAPER NUMBER

1639

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/997,564

Applicant(s)

SCHEMBRI, CAROL T.

Examiner

My-Chau T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 17-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 17 and 21-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 . 6) ☐ Other: _____

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DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group III (Claims 18-19) in Paper No. 5 (10/8/03) is acknowledged.

The traversal is on the ground(s) that Group IV (Claim 20), Group V (Claims 21-23), and Group VI (Claim 24-27) be rejoined with Group III. Group IV should be rejoin with Group III because Group IV is the species of the generic claims of Group III. Group V should be rejoin with Group III because Group V includes the claimed array of Group III. Group VI employed the array of Group III.

Applicant's argument with respect to rejoining Group IV (Claim 20) with Group III (Claims 21-23) has been fully considered and is persuasive. Group IV is rejoin with Group III, thus Group III is now Claims 18-20.

Applicant's arguments with respect to rejoining of Group V (Claims 21-23) with Group III and Group VI (Claims 24-27) with Group III are not found persuasive because Group III and Group V have different required components that have different modes of operation and different functions (e.g. the combination of a deblocking agent and a plurality of resistors of Group V are not required by the claims of Groups III). The array of Group III as claimed can be used to practice another and materially different process such as the process of protein synthesis than the process claimed in Group VI. Therefore, Group V and Group VI are not rejoined with Group III.

The requirement is still deemed proper and is therefore made FINAL.

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2. Claims 1-7, 17, 21-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5 (10/8/2003).

Information Disclosure Statement

3. The information disclosure statement(s) (IDS) submitted by applicant filed on 11/28/01 is acknowledged and considered.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Ribí et al. (US Patent 5,491,097).

Ribí et al. disclose a bioelectronic sensor device (col. 2, lines 53-67). The bioelectronic sensor device comprising an electrically insulating solid support (substrate), a highly oriented polymerized film that is electrically semiconducting, and distal from the support is a member of a specific binding pair joined to the film (col. 3, lines 15-22; fig. 3 and 5). The electrodes (resistors) are formed on the non-conducting substrate followed by the coating with the electrically conducting polymer (col. 9, lines 60-67). The electrodes are beneath the surface of

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the substrate (col. 3, lines 19-28). A member of a specific binding pair includes polymer such as oligonucleotides (col. 8, lines 37-44). Therefore, the device of Ribí et al. anticipates the presently claimed invention.

6. Claims 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Heller et al. (US Patent 5,605,662).

Heller et al. disclose an electronic sensor device (abstract). The device comprises a plurality of micro-locations wherein each micro-location includes a surface for covalent attachment of specific binding entities, and an underlying microelectrode (resistors) (col. 5, lines 24-44; col. 9, line 18-20; col. 10, lines 5-15). The specific binding entities includes polymer such as nucleic acid (col. 16, line 43-67). Therefore, the device of Heller et al. anticipates the presently claimed invention.

7. Claims 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Hollis et al. (US Patent 5,653, 939).

Hollis et al. disclosed a sensor array (col. 4, lines 17-49; col. 6, lines 38-41). The array comprises a plurality of test sites (col. 5, lines 36-40) wherein each test sites comprise a substrate, resistors, and a silicon oxide film (e.g. the resistors are beneath the substrate surface) (col. 5, lines 11-15, and lines 30-32). The test sites further comprise of oligonucleotide strands (col. 6, lines 38-45). Therefore, the array of Hollis et al. anticipates the presently claimed invention.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 703-305-6999. The examiner can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang can be reached on 703-306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

mct
January 23, 2004


PADMASHRI PONNALURI
PRIMARY EXAMINER